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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,694	12/30/2003	Nathaniel Blake Scholl	026014-002301US	2002
20350 7590 10/29/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER RETTA, YEHDEGA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/29/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/748,694

**Applicant(s)**

SCHOLL, NATHANIEL BLAKE

**Examiner**

Yehdega Retta

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 9-18, 20 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 9-18, 20 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to Request for Continued Examination filed August 26, 2009. Applicant amended claims 1, 2, 4, 5, 9, 13-16, 24 and 25. Claims 1, 2, 4, 5, 9-18, 20, 24-31 are currently pending.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 9-18, 20 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thrall (US 2005/0120311 A1) in view of Skinner et al. (US 2005/0105677 A1).

Regarding claims 1 and 4, 5, 9-13, 20, 24 and 31, Thrall teaches under control of one or more computer systems configured with executable instructions; receiving search data relating to previously-executed searches the search data indicating search terms submitted by users; placement of links to information for the item, whether users selected the link for the item from the search results; determining extent (score) based on frequency of selection; the score being greater for the a higher page (see abstract, [0007]- [0020], [0075]-[0080]). Thrall teaches using the score to determine the rankings for the display of future search result for example by displaying the link for the item toward the top of the future search result (see [00009]-[0011], [0074]). Skinner teaches upon receiving a search request containing a search term determining to place an advertisement for the item on the first page of the search results (see col. 1 line 62 to

col. 2 line 25, col. 9 lines 49-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to determine to place advertisement related to an item on the first page of Thrall's search result listing, as in Skinner, since premium placement of an advertisement is on the first page, which provides a high volume of traffic to the advertisement's web site, as taught in Skinner.

Regarding claims 14 and 25, Thrall teaches search engine service provides the link of a search result without payment of an advertisement fee (search result are provided to the user without advertiser paying advertisement fee) see [0005]-[0008] see also Skinner col. 1 lines 20-25).

Regarding claims 15-18, 26-30, Skinner teaches wherein fee is paid for requesting placement of the advertisement; advertisement paid for on a cost-per-selection (col. 1 line 20 to col. 2 line 46). Skinner teaches while some search engines rely upon algorithms that select and organize the listing of web pages based on multiple criteria, such as keyword density and keyword location, others allow advertisers themselves to influence their placement in search result listings to that their listing are prominent in searches that are relevant to the content of their website. It would have been obvious to one of ordinary skill in the art at the time of the invention for the advertisers to pay for each click-through, in Thrall search result, since the advertisers have an incentive to select and bid for the highest position because the higher the advertiser's position (first page or top listings) on a search result list the higher the likelihood of a referral, as taught in Skinner.

*Response to Arguments*

Applicant's arguments with respect to claims 1, 2, 4, 5, 9-18, 20 and 24-31 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622